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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,932

07/15/2003

Rebecca L. Engel

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MEDTRONIC, INC.
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EXAMINER

MEDWAY, SCOTT J

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

12/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/619,932</p>	<p>Applicant(s) ENGEL ET AL.</p>	
	<p>Examiner SCOTT MEDWAY</p>	<p>Art Unit 3763</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 27 October 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art Unit 3763

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments with respect to the claimed invention are not persuasive.

Applicant argues that de la Rama does not disclose the claimed slits. Examiner disagrees and directs Applicant to Fig. 3 of de la Rama. de la Rama very clearly shows eye-shaped slits which have first and second corners defined by arcuate portions that intersect each other, with the spatial arrangement of the major and minor axes meeting the limitations of the claimed invention.

Further, Applicant argues that de la Rama fails to disclose corners of the apertures that do not buckle outwardly as the cannula is flexed. Since de la Rama is silent to the disclosure that the corners of the apertures buckle outwardly when flexed, and nothing in de la Rama suggests that the apertures would perform in such a way, Examiner concludes that at least some flexing of the catheter would not require that the corners buckle outwardly. Applicant has not defined what is meant by "outwardly" and it is not known to what spatial direction "outward" is referring. Examiner asserts that the corners of the apertures of de la Rama would remain fairly stationary if the tube of de la Rama was buckled, and the corners would not "buckle outwardly". Additionally, Applicant is reminded that the phrase "the corners do not buckle outwardly as the cannula is flexed" (claim 8, line 10-11) recites an intended use limitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Further, Applicant argues that modifying the apertures of Ash according to the teaching of de la Rama would not be successful. Examiner disagrees. Nothing in the references of Ash or de la Rama or within the knowledge of those of ordinary skill in the art would suggest that forming apertures with a formerly undisclosed shape so that they take on an eye-type shape would render the reference of Ash unsuitable for its intended purpose of facilitating fluid intake. Nothing in de la Rama suggests that the slits 12 seal the tube of de la Rama to be completely closed off to fluid until the tube is buckled. Even assuming that the catheter of Ash would be optimally flexed in order to open the slits (which is not suggested or disclosed by de la Rama), the catheter of Ash is flexible enough to bend to open the slits in order to draw fluid into the catheter, while still allowing the slits to perform their intended use in an improved manner.